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| 10/526,493 | 03/30/2006 | Ibrahim H. Ibrahim | COCH-0145-US1 | 7351 |
| 30678 7590 10/16/2008 CONNOLLY BOVE LODGE & HUTZ LLP 1875 EYE STREET, N.W. SUITE 1100 WASHINGTON, DC 20006 | | | | |
| EXAMINER | | | | |
| DIETRICH, JOSEPH M | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/526,493

Applicant(s)

IBRAHIM, IBRAHIM H.

Examiner

Joseph M. Dietrich

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 and 58 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-33 and 58 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 04 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date 3/4/05
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 23 – 29, 32, and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding **claims 23 and 24**, there is no connection between any of the elements because the external and implanted transceivers have yet to be positively recited. They have only been functionally recited in the independent claim, rendering their use in the claims vague and incomplete.

Claim 32 recites the limitation "turns of the external transceiver" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Regarding **claim 33**, it is unclear whether the peak detector means is being positively or functionally claimed. It is suggested to first positively recite the peak detector before describing how the peak detector is used.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 4, 11, 12, 16 – 19, 28, and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Jeutter (U.S. Patent 5,314,453).

Regarding **claims 1 – 4, 11, 12, 16 – 19, 28, and 29**, Jeutter discloses a method and apparatus comprising a means for measuring the strength of a magnetic field (e.g. column 6, lines 4 – 12); means for determining the position of the external device relative the implant and indicating through use of a visible indication that the device is displaced when the measured strength exceeds a threshold value (e.g. column 4, line 67 – column 5, line 10).

3. Claims 1 – 7, 11 – 22, 28 – 32, and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen et al. (U.S. Patent 6,138,681).

Regarding **claims 1 – 7, 11– 22, 28 – 32, and 58**, Chen discloses a method and apparatus comprising a means for measuring the strength of a magnetic field (e.g. column 4, lines 25 - 30); means for determining the position of the external device relative the implant (e.g. column 4, lines 33 - 36); means for indicating the external device is displaced when the measured strength exceeds a threshold value (e.g. column 6, lines 3 – 15); means for mapping that comprises a look-up table comprising a plurality of pairs of values of magnetic field strength to separation distance (e.g. column 6, lines 3 – 15); wherein the means for measuring comprises a pickup coil positioned in a plane substantially perpendicular to a primary axis of the magnetic field and comprising an open circuited single turn (e.g. column 4, lines 50 – 58).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8 - 10, 23 - 27, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. as applied to claim 1 above, and further in view of Bornhoft et al. (U.S. Patent Application Publication 2003/0074035).

Regarding **claims 8 – 10, and 23 – 27**, Chen discloses the claimed invention except a bidirectional transcutaneous link. Bornhoft teaches that it is known to use transceivers having a bidirectional RF telemetric link for the transmitting of power and data signals as set forth in paragraphs 13, 14, and 29. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the transcutaneous link as taught by Chen with the bidirectional RF link as taught by Bornhoft, since such a modification would provide the predictable results of minimizing the amount of circuitry in both the implanted device and the external device while still allowing both data and power to be transferred from one device to another.

Regarding **claim 33**, Chen discloses the claimed invention except for peak detecting means. Bornhoft teaches that it is known to use peak detecting means to determine the magnetic strength as set forth in paragraph 25. It would have been

obvious to one having ordinary skill in the art at the time the invention as made to modify the pick-up coil as taught by Chen with the peak detecting means as taught by Bornhott, since such a modification would provide the predictable results of efficiently determining the amplitude of the received signal, and thus determining the positioning of the external device relative the implanted device.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph M. Dietrich whose telephone number is (571)270-1895. The examiner can normally be reached on M-F, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. D./
Examiner, Art Unit 3762
10/10/08

/George R Evanisko/
Primary Examiner, Art Unit 3762